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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,608	01/18/2002	Lee Macklin	10011295-1	2966

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

NEWTON, JARED W

ART UNIT	PAPER NUMBER
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3692

MAIL DATE	DELIVERY MODE
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09/19/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/052,608	MACKLIN ET AL.
Examiner	Art Unit	
Jared W. Newton	3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 23 January 2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-23 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-23 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

DETAILED ACTION

This Final Rejection is in reply to the Amendment filed January 23, 2007, by which no claims were amended. Claims 21-23 are new. Claims 1-20 are pending.

At the outset, it is noted that the prosecution of this Application has been reassigned to the undersigned Examiner, Jared Newton.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the Disclosure as originally filed does not contain sufficient support for the limitations: "at least one individual originates the disbursement request and said authorization process includes a determination whether approval is required from at least one individual different from said at least one individual that originates said disbursement requests" (claim 21); "wherein at least one individual originates the disbursement request and said predetermined rules include determining whether approval is required from at least one individual different from said at least one individual originating the disbursement request" (claim 22); or "wherein at

least one individual originates said payment request and said authorization module determines whether approval is required from at least one individual different from said at least one individual originating said payment request" (claim 23).

The noted limitations should be canceled from the claims.

The Remarks filed January 23, 2007, and related to the newly added claims, are addressed in the ***Response to Arguments*** section below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-3, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by McGurl et al, U.S. Patent No. 5,893,080.

Claim 1: McGurl discloses a "network based payment processing system comprising:

an input process configured to receive disbursement requests (Col. 2 lines 49-52),

an authorization process configured to apply predetermined rules to control verifying proper authorization of said disbursement requests (Col. 4 18-23, Col. 6 lines 6-13; Col. 6 lines 28-32),

an accounting process configured to track parameters pertaining to the fulfillment of authorized ones of said disbursement requests (Col. 5 lines 36-41, Col. 6 lines 28-32, Col. 6 lines 39-41), and

an output process configured to process said disbursement requests for payment (Col. 5 lines 13-36)."

Claim 2: McGurl discloses a "network based payment processing system of claim 1 wherein said input process includes a communications interface to an intranet (Col. 3 lines 27-38)."

Claim 3: McGurl discloses a "network based payment processing system of claim 1 wherein said input process includes a graphical user interface (Col. 3 lines 55-59)."

Claim 8: McGurl discloses a "network based payment processing system of claim 1 wherein said output process is further configured to initiate an electronic fund transfer to effect said payment to a recipient (Fig. 1 item 34; Col. 4 lines 54-59)."

Claim 9: McGurl discloses a "network based payment processing system of claim 1 wherein said output process is further configured to generate a negotiable instrument in a tangible form to effect said payment to a recipient (Fig. 1 item 36; Col. 4 lines 54-59)."

Claim 21: McGurl discloses at least one individual user originating the disbursement request at the receiving means 12, and then the authorization (i.e. the determination of whether the disbursement request is permitted to pass) is accomplished by a second individual, the generator means 18 (see col. 4, lines 16 – 32).

Claims 10-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Kahn et al, U.S. Patent No. 6,401,079.

Claim 10: Kahn discloses a "network based method of disbursing funds, said network based method including the steps of:
receiving a disbursement request (Fig. 3 item 1110; Col. 18 lines 30-32);
applying predetermined rules to authorize said disbursement request (Abstract; Col. 15 lines 20-31);
supvising [sic] the proper approval based on applied ones of said authorization rules (Abstract; Col. 5 lines 25-35);

tracking available funds from which said disbursement is to be drawn (Col. 6 lines 8-23); and

processing said disbursement for payment (Col. 5-6)."

Claim 11: Kahn discloses a "method of claim 10 wherein said disbursement receiving step includes the step of receiving said request over an intranet (Fig. 1 item 15)."

Claim 12: Kahn discloses a "method of claim 10 further including the step of presenting a graphical user interface to said requesting party (Figs. 5-46b)."

Claim 13: Kahn discloses a "method of claim 10 wherein one of said predetermined rules denies authorization of said request when a requesting party is identical to a receiving party (Col. 48 lines 9-14; Col. 5 lines 47-51)."

Claim 14: Kahn discloses a "method of claim 10 wherein one of said predetermined rules denies authorization of said request when said request exceeds a maximum authorization amount (Col. 14 lines 56-59)."

Claim 15: Kahn discloses a "method of claim 10 wherein one of said predetermined rules denies authorization of said request when said request is not complete (Col. 17 lines 64-67, Col. 18 lines 1-10; Col. 40 lines 29-36)."

Claim 16: Kahn discloses a "method of claim 10 wherein said step of tracking includes the step of tracking a plurality of disbursement categories (Col. 24 lines 54-63)."

Claim 17: Kahn discloses a "method of claim 10 further including the step of transferring a payment via electronic fund transfer (Fig. 3 item 1160)."

Claim 18: Kahn discloses a "method of claim 10 further including the step of generating a negotiable instrument in a tangible form to effect said payment to a recipient (Fig. 3 item 1150)."

Claim 19: Kahn discloses a "payment system comprising:
a web server configured to host a payment processing site for receiving payment requests (Fig. 3 item 1100, Fig. 1 item 15; Col. 18 lines 17-32);
an authorization module configured to control proper authorization of said payment requests to provide approved payments (Col. 54 lines 54-56, Col. 55 lines 1-46, Col. 56 lines 46-50);
an accounting module configured to verify fund availability and to track fund disbursement in connection with said approved payments (Col. 50 lines 8-29; Fig. 43; Col. 51 lines 64-67, Col. 52 lines 1-34); and
a payment module configured to initiate payment to recipients designated in connection with said approved payments in response to said verification of fund availability and said proper authorization (Fig. 3 item 1140)."

Claim 20: Kahn claims a "payment system of claim 19 wherein said authorization module includes a routing module configured to obtain authorization of said payment from a number of authorization entities (Col. 54 lines 54-56, Col. 55 lines 1-46, Col. 56 lines 46-50)."

Claim 22: Kahn further discloses at least one individual (i.e. an employee, etc. – see col. 5, lines 41-50) originating the disbursement request and said rules including determining whether approval is required from at least one individual different (i.e. the

system of the invention – see FIG. 43; col. 49, lines 10-15) from said at least one individual originating the disbursement request.

Claim 23: Kahn further discloses at least one individual (i.e. an employee, etc. – see col. 5, lines 41-50) originating the disbursement request and authorization module determining if approval is required from at least one individual different (i.e. the system of the invention – see FIG. 43; col. 49, lines 10-15) from said at least one individual originating the payment request.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGurl as applied to claim 1 above, and further in view of Kahn et al, U.S. Patent No.

6,032,133. McGurl does not specifically discloses a “network based payment processing system of claim 1 wherein said predetermined rules include a rule denying authorization when a disbursement request has a requesting party that is not different from a designated recipient specified in said disbursement request.” However, Kahn discloses such a system (Col 5 lines 47-51, Col. 48 lines 9-14). It would have been obvious to one skilled in the art to combine these references because doing so gives the employer greater control over the payroll approval process, possibly preventing theft by employees. Kahn offers the motivation to combine, stating that the system creates security that allows the employer greater control the approval of payments to employees (Col. 48 lines 9-14).

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGurl as applied to claim 1 above, and further in view of Hilt, U.S. Patent No. 6,032,133. McGurl does not disclose a “network based payment processing system of claim 1 wherein said predetermined rules include a rule denying authorization when a disbursement request has exceeded a limit.” However, Hilt does disclose a bill pay system that reads an account balance to determine if sufficient funds are available to pay a bill and denies the transaction if the available balance is not sufficient (Col. 21 lines 5-12; Fig. 11 items 254, 256, 258). It would have been obvious to one skilled in the art to combine the two references because doing so prevents the issuance of checks that will not be honored due to insufficiency of funds. Hilt provides the motivation to combine these references when it is states that a check denied due to insufficient funds creates significant costs for the banks involved (Col. 5 lines 14-20).

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGurl as applied to claim 1 above, and further in view of Kahn et al, U.S. Patent No. 6,032,133. McGurl does not disclose a “network based payment processing system of claim 1 wherein said accounting process includes logic for tracking multiple awards to a particular recipient.” However, Kahn does disclose a system that allows for the tracking of multiple awards to a particular recipient (Col. 11 lines 57-65, Col. 12 lines 1-10). It would have been obvious to one skilled in the art to combine these two references because to do so provides systems users with greater control over, and understanding of, payroll-related data. Kahn offers the motivation to combine these references when it offers that keeping track of employee data allows for easier compliance with federal, state and local tax and employment requirements (Col. 1 lines 26-30; Col. 5 lines 24-34).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGurl as applied to claim 1 above, and further in view of Kahn. McGurl does not disclose a “network based payment processing system of claim 1 wherein said accounting process is further configured to track multiple funds corresponding to plurality of disbursement categories.” However, Kahn does make this disclosure (Col. 5 lines 1-12, Col. 6 lines 1-23). It would have been obvious to one skilled in the art to combine these references because to do so imparts greater capability on the McGurl system by allowing it to process not only regular payroll wage data but to also process tax and non-wage data. The motivation to combine the references is supplied by Kahn when it offers that the

inclusion of this capability allows a company to more easily comply with tax rules, employment rules and company policies (Col. 5 lines 24-34).

Response to Arguments

New Claims 21-23:

With respect to the newly added claims 21-23, the claims are deemed improper New Subject Matter pursuant to 35 USC § 112, first paragraph. In his remarks, Applicant recites, "The subject matter of these new claims is present in the specification, inter alia, at paragraphs [0013] & [0014]; Fig. 2, items 204, 211 and 212." (Remarks, page 7). Upon review of the application, and in particular the noted portions, the Examiner has been unable to find support for the limitations of the newly added claims sufficient enough to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant's arguments filed January 23, 2007 have been fully considered but they are not persuasive:

Rejections under 35 USC § 102(b) – US Patent No. 5,893,080 to McGurl:

With respect to the McGurl reference, Applicant recites, "In McGurl, as cited by Examiner, there is no teaching of the authorization of disbursement requests ... or ... anything whatsoever about authorization of a disbursement request." (Remarks, pages 7-8). To the contrary, McGurl teaches the authorization of a disbursement request at

least when that limitation is given its broadest reasonable interpretation in view of the Specification. Claim 1 requires “an authorization process configured to apply predetermined rules to control verifying proper authorization of said disbursement requests” (lines 3-4). McGurl teaches a “Disbursement System and Method” (title). The disbursements disclosed by McGurl are generated in response to “disbursement requests” (col. 4, lines 16-23). For the disbursement to be effected, the requests must correspond to “disbursement criteria” in a database 20 (see col. 4, lines 23-32). If such a correspondence exists, the disbursement request is processed (see id).

“To authorize” is defined as “to give permission for” (Webster’s II New Riverside Dictionary (hereafter Webster’s)). The Specification of the instant Application does not give reason to qualify the term beyond this definition. The Specification recites, “The authorization module is configured to apply predetermined rules which, for example, verify the authorization of the requesting party to request or approve such a request.” (Pre-grant Publication, paragraph [0006]). In other words, the “authorization” of the instant Application grants permission for a requesting party to proceed with a request.

This interpretation fits squarely within the teachings of the McGurl reference, which permits a request to proceed when the request corresponds to “disbursement criteria” stored in a database (see col. 4, lines 23-32). The grant of the permission by the system is “authorization” at least within the broadest reasonable interpretation of that term.

Furthermore, the system of McGurl comprises a “monitoring means 28” for monitoring the system in use (see col. 6, lines 6-12). If the monitoring means detects a

"fault condition," it prevents the effectuation of the disbursement (see id). Put another way, the monitoring means is capable of granting or denying permission for the disbursement request to continue. Put yet another way, the monitoring means is an additional means for authorizing or not authorizing the disbursement.

With further respect to the McGurl reference, the Applicant recites, "because McGurl does not teach the authorization of disbursement requests, McGurl does not teach the further limitation ... 'an accounting process configured to track parameters pertaining to the fulfillment of authorized ones of said disbursement requests...'" (Remarks, page 8). As set forth immediately above, the McGurl reference discloses the authorization of disbursement requests. McGurl further teaches the tracking of parameters related to disbursements requests that are authorized to proceed. McGurl recites, "After disbursement has been effectuated, the information used to generate the disbursement is stored in database means 20 for later retrieval, auditing, and/or use in reports generated by audit generating means 26, in the manner that will be described more fully below" (col. 5, lines 35-40). The teaching of storing information used to generate disbursements is deemed to anticipate the noted limitation at least in view of its broadest reasonable interpretation.

In view of these teachings, the rejections based on the McGurl reference are hereby maintained. Applicant contends that McGurl does not anticipate claims 2, 3, 8 and 9 because they depend from claim 1. However, in view of the upholding of the McGurl reference as anticipating the limitations of claim 1, the rejections of claims 2, 3, 8 and 9 are also upheld.

It is noted that in the Non-final rejection mailed November 17, 2006, the Examiner specified citations of the McGurl reference representative of the teachings of that reference. Notwithstanding those specific citations, the rejections under McGurl were based on the reference in its entirety, and therefore the reference as a whole must be considered when refuting its application to the present claims.

Rejections under 35 USC § 102(e) – US Patent No. 6,401,079 to Kahn:

With respect to the Kahn reference, and in particular claim 10, Applicant recites, "Kahn does not include rules that authorize the disbursement request" (Remarks, page 9). To the contrary, Kahn discloses a system for web-based payroll administration (see title), and explicitly recites, "The system's back-end payroll service functionality generates disbursement information for payments ... subject to compliance with the system's database of rules" (abstract, lines 33-39) (emphasis added) and further "effects such transfers at the appropriate times" (col. 6, lines 8-13). In view of this explicit disclosure of Kahn, the Examiner upholds the rejections based thereon as anticipating the noted limitations at least in view of their broadest reasonable interpretation.

With respect to claim 19, Applicant recites, "Kahn does not teach an authorization module configured to control proper authorization of said payment requests to provide approved payments" (Remarks, page 10). In view of the plain meaning of the explicit disclosure of Kahn set forth immediately above, the limitations are deemed anticipated. A "module" is "one of a series of standardized units or

components that function together in a system" (Webster's Dictionary). Kahn teaches a system, wherein one component of the system (the "back-end service") is configured to accept payment requests, for example, requests by employees or requests for payments to retirement benefit providers (see col. 5, lines 41-50). The disbursements of the payments are "subject to compliance with the ... database of rules" (see col. 6, lines 1-13). Therefore, subject to the rules, the disbursement is either effected or not effected, that is, authorized or not authorized to proceed.

Applicant also recites, "Kahn ... does not teach ... a payment module configured to initiate payment to recipients designated in connection with approved payments in response to verification of fund availability and proper authorization" (Remarks, page 11). As set forth immediately above, Kahn teaches the authorization of funds disbursement. Kahn further teaches that before the funds are disbursed, verification is made as to whether there are "sufficient" funds to effect the disbursement payments (see FIG. 43).

In view of these teachings, the rejections based on the Kahn reference are hereby maintained. Applicant contends that Kahn does not anticipate claims 11-18 and 20 because they depend from either claim 10 or 19. However, in view of the upholding of the Kahn reference as anticipating the limitations of claims 10 and 19, the rejections of claims 11-18 and 20 are also upheld.

It is noted that in the Non-final rejection mailed November 17, 2006, the Examiner specified citations of the Kahn reference representative of the teachings of that reference. Notwithstanding those specific citations, the rejections under Kahn were

based on the reference in its entirety, and therefore the reference as a whole must be considered when refuting its application to the present claims.

Rejections under 35 USC § 103(a):

Applicant contends that the rejections of claims 4-7 under 35 USC § 103(a) are not proper because the claims depend from a base claim rejected by the McGurl reference. However, in view of the upholding of the Kahn reference as anticipating the limitations of claim 1, the rejections of claims 4-7 are similarly upheld.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared W. Newton whose telephone number is (571) 272-2952. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JWN
September 12, 2007



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